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In re Application of :
HOFFMANN, Olaf, et al. :
U.S. Application No.: 08/913,184 : **DECISION ON PETITION**
PCT No.: PCT/DE96/00457 :
International Filing Date: 05 March 1996 :
Priority Date: 07 March 1995 :
Attorney's Docket No.: 6553 US :
For: COMMUNICATIONS AND MEASUREMENT :
APPARATUS :

This decision is issued in response to the "Request For Status Of Petition To Revive An Unintentionally Abandoned Application" and the attached "Petition To Revive An Unintentionally Abandoned Application Pursuant To 37 CFR 1.182(b)" and "Response To Notice To File Missing Parts Of Application" filed 06 August 2001.

BACKGROUND

On 05 March 1996, applicants filed international application PCT/DE96/00457 which claimed a priority date of 07 March 1995 and which designated the United States. On 12 September 1996, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 07 October 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire 30 months from the priority date, i.e., 07 September 1997.

On 07 September 1997, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English. The transmittal letter noted that the international application had been transmitted by the IB.

On 03 December 1997, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The

Notification also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 16 July 1998, the DO/EO/US mailed a "Notification Of Abandonment" (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a timely response to the Notification of Missing Requirements.

On 06 August 2001, applicants filed a "Request For Status Of Petition To Revive An Unintentionally Abandoned Application." This status request asserts that a "Petition To Revive" the application and a "Response To Notice To File Missing Parts Of Application" was previously filed on 16 February 1999. Among the attachments to the status request are copies of the Petition To Revive and the Response To Notice To File Missing Parts, as well as a postcard that specifically identifies this application, itemizes these materials, and bears a USPTO receipt stamp dated 16 February 1999. Based on applicants' statements and the stamped return postcard, it is concluded that the Petition To Revive and the Response To Notice To File Missing Parts attached to the present status request were originally filed on 16 February 1999. However, the return postcard does not itemize the declaration attached to the present petition (note that the box adjacent to the "Declaration/Power of Attorney" portion of the postcard receipt was not checked). Accordingly, the declaration is treated as having been filed for the first time with the present submission on 06 August 2001.

DISCUSSION

The Petition To Revive states that it is made under 37 CFR 1.182(b). However, because it refers to an unintentional abandonment and authorizes a charge for the proper fee for a petition under 37 CFR 1.137(b), the petition has been treated as a petition under 37 CFR 1.137(b).

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, the "required reply" was a proper response to the Notification of Missing Requirements, that is, a declaration in compliance with 37 CFR 1.497 and payment of the \$130 surcharge for filing the declaration after the thirty month deadline. As discussed above, it is

concluded that the Response To Notice To File Missing Parts Of Application attached to the present submission was originally filed on 16 February 1999; this Response includes the authorization to charge applicants' Deposit Account the required surcharge. The executed declaration in compliance with 37 CFR 1.497(a) and (b) was included with the present submission on 06 August 2001. Accordingly, as of 06 August 2001, applicants have made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner. Applicants have therefore submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The Petition To Revive provides authorization to charge Deposit Account No. 20-0352 for the petition fee. Item (2) is satisfied.

As for item (3), the Petition To Revive states that "the delay in responding to the outstanding Notice Of Missing Parts was unintentional in that Applicants' former law attorney never received the communication from the U.S. Patent and Trademark Office." This statement refers only to the period between the abandonment and the filing of the Response To Notice To File Missing Requirements on 16 February 1999. However, as noted above, applicants have not made a prima facie case that the executed declaration was filed on 16 February 1999; rather, the declaration appears to have been submitted for the first time on 06 August 2001. Because applicants' statement regarding the delay does not address the period from 16 February 1999 to 06 August 2001, it cannot be construed as being the statement required by 37 CFR 1.137(b)(3), that is, a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." Accordingly, item (3) under 37 CFR 1.137(b) is not satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

Because applicants have failed to satisfy item (3) for a grantable petition under 37 CFR 1.137(b), the petition cannot be granted.

CONCLUSION

Applicants' Petition To Revive, considered filed on 16 February 1999, is **DISMISSED** without prejudice. The application remains abandoned.

Deposit Account No. 20-0352 will be charged \$1,210 as the fee for the Petition To Revive and \$130 as the surcharge for filing the declaration later than thirty months after the priority date.

The Response To Notice To File Missing Parts Of Application attached to the present status request is considered to have been filed on 16 February 1999.

The declaration included with the present submission is treated as having been filed on 06 August 2001.

If reconsideration on the merits of this petition is desired, a proper response must be submitted within **TWO (2) MONTHS** of the mail date of this decision. Such response should be titled "Renewed Petition Under 37 CFR 1.137(b)" and include the statement required by 37 CFR 1.137(b), as discussed above.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 200231, and address the contents of the letter to the attention of the Legal Affairs Division of the PCT Legal Office.



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